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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/050,834	01/15/2002	Kelly Molenaar	MSH-203RCE	1333
8131 7590 04/22/2010 MCKELLAR IP LAW, PLLC 784 SOUTH POSEYVILLE ROAD MIDLAND, MI 48640				
EXAMINER				
MACARTHUR, VICTOR L				
ART UNIT		PAPER NUMBER		
3679				
MAIL DATE		DELIVERY MODE		
04/22/2010		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/050,834

**Applicant(s)**

MOLENAAR, KELLY

**Examiner**

VICTOR MACARTHUR

**Art Unit**

3679

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11/15/2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-7, 9 and 11-23 is/are pending in the application.
- 4a) Of the above claim(s) 3, 5-7, 19 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4, 11-18 and 21-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB06)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

#### **DETAILED ACTION**

##### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/15/2010 has been entered.

##### ***Election/Restrictions***

Applicant's election without traverse of the group I ball joint, and the external thread species of claim 4, provisionally in the interview noted in the 4/9/2003, and affirmed in the reply filed 8/12/2003 remains acknowledged.

Claims 3, 5, 6, 7, 19 and 20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to the nonelected group II automotive suspension system of claim 3, nonelected flange species of claims 5 and 19, and nonelected compression fit species of claims 7 and 20, there being no allowable generic or linking claim.

Note that even though claim 3 has been amended to depend from claim 9, the claim 3 automotive suspension system still does not require the particulars of the claim 9 ball joint in that claim 3 only requires an “upper ball joint system” and “lower ball joint system”, neither of which terms find antecedent basis in claim 9.

### ***Specification***

The disclosure is objected to because for failing to expressly set forth the corresponding structure, material, or acts that perform the claimed means (or step) plus function limitation “a means for attaching” (claim 9) and “a means for attachment” (claim 14). Pursuant to 37 CFR 1.75(d) and MPEP §§ 608.01(o) and 2181, applicant is required to:

- Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- Amend the written description of the specification such that it expressly recites the corresponding structure, material, or acts that perform the claimed function and clearly links or associates the structure, material, or acts to the claimed function, **without introducing any new matter** (35 U.S.C. 132(a));

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, 9, 11-18 and 21-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear if and/or precisely how “a means for attaching” (claim 9) and “a means for attachment” (claim 14) are meant to invoke 35 U.S.C. 112, sixth paragraph since the written description fails to disclose the corresponding structure, material, or acts for the claimed function. Applicant is required to:

- Amend the claim so that the claim limitation will no longer be a means (or step) plus function limitation under 35 U.S.C. 112, sixth paragraph; or
- Amend the written description of the specification such that it clearly links or associates the corresponding structure, material, or acts to the claimed function **without introducing any new matter** (35 U.S.C. 132(a)).

It is unclear how the claim 4 “external thread” can be in addition to the previously recited “means for attaching” of claim 9. Aren’t the external thread of claim 4 and the means of claim 9 one and the same?

It is unclear what element the pronoun “its” (line 27 of claim 9) is meant to refer.

It is unclear if the claim 14 recitation “a socket” is meant to refer to the previously recited claim 9 socket or to an additional socket.

The term “said socket” (line 4 of claim 17) lacks proper antecedent basis.

The term “said housing” (line 4 of claim 17) lacks proper antecedent basis.

It is unclear if “a surface of the ball portion” (line 13 of claim 17) is meant to refer to “the surface of the ball portion” (line 7 of claim 17) or to an additional surface.

Claim 21 is replete with double inclusions (e.g., “a duct”, “a passageway”, “a pressurized lubricant”, etc.) such that it is unclear if the recitations are meant to refer to the previous recitations in claim 17 or to additional elements.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 9, 11-18 and 21-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Scheublein USPN 3103377 in view of Maughan USPN 5564853.

Scheublein discloses (figs.3 and 5) a metal (note metal and stipple metal cross hatching) ball joint comprising: a shaft (61), ball (60, 62) having a truncated face (flat face at end of 60), housing (55, 63) having a curved seat (curved seat of 63), threaded opening (opening having 65), middle portion (middle portion of 55) and means for attaching (56); a retaining member (66) having a curved seat (72), lubricating port (75) and external thread (thread of 66 engaging 65). Scheublein fails to disclose a set screw. However:

- Maughan 5564853 teaches that set screws are desirable for locking an internally threaded housing (208) to an externally threaded retaining member (244) thereby better preventing unintentional disassembly.
- Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Scheublein to have a set screw, as taught by Maughan, for the purpose of better preventing unintentional disassembly.

As detailed above, the prior art structure is substantially identical to the claimed structure such that the PTO must presume claimed functions/properties (“for use with a pressurized lubricant”, “capable of permitting the admission of pressurized lubricant... to maintain the ball

against the seat”, “capable of maintaining a seal between the ball and housing via the pressure”, etc.) to be inherent, thus presenting a *prima facie* case and properly shifting the burden to prove otherwise with evidence to the applicant. It is fairly the applicant's burden to obtain and test the prior art since the Patent Office is unable to manufacture or obtain prior art products. Mere allegation that the prior art does not inherently possess capability to perform applicant's claimed functions/properties is not sufficient without actual evidence proving as much. The MPEP sections and case law below clearly set forth that that product claims are limited by structure and that functional limitations only limit a claim in so far as they require further specific structure. One cannot obtain patentability for a product structure by merely reciting an intended functional use thereof; at least not without testing structurally similar prior art structures and providing evidence proving incapability of such intended functional use thereof. The burden of such testing lies fairly with the applicant since it is applicant, not the PTO, who is endeavored in the making and using of products. Note the following:

- MPEP §2112.01 (I);
- MPEP §2114;
- *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987);
- *In re Ludtke*, 441 F.2d 660, 664, 169 USPQ 563, 566 (CCPA 1971);
- *In re Brown*, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972);
- *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433-34 (CCPA 1977);
- *In re Schreiber*, 128 F.3d 1473, 1478 44 USPQ2d 1429, 1432 (Fed.Cir.1997);
- *Hewlett-Packard Co. v. Bausch & Long Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990);

- *In re Swinehart*, 58 CCPA --, --F.2d --, 169 USPQ 226 (1971);
- *In re King*, 801 F.2d 1324, 1327, 231 USPQ 136, 138 (Fed. Cir. 1986);
- *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed.Cir. 1990);
- *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965);

Further regarding claims 11, 12, 17-23 note the following:

- the examiner takes **OFFICIAL NOTICE** that it was extremely well known for a housing to be an integrally formed unitary component, and for a retaining member to be an integrally formed unitary component.
- MPEP 2144 clearly states that "The rationale to modify or combine the prior art does not have to be expressly stated in the prior art; the rationale may be expressly or impliedly contained in the prior art or it may be reasoned from **knowledge generally available to one of ordinary skill in the art, established scientific principles, or legal precedent established by prior case law**" (emphasis added).
- One of ordinary skill in the art (one skilled and knowledgeable enough to design, manufacture, and use ball joints) would know that unitary one-piece integral construction would reduce the number of parts thus simplifying assembly.
- MPEP 2144.04(V)(B) details that making separate parts integral is obvious unless there is some unexpected result (criticality) that is contrary to the understandings and expectations of the art, citing *In re Larson*, 340 F.3d 965, 968, 144 USPQ 347, 349 (CCPA 1965), *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983).



- MPEP 2144.04 states "If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection" (emphasis added). However, applicant's disclosure, and all other evidence of record, fails to set forth any unexpected result due to any specific to unitary construction over multiple piece construction. Accordingly, the claimed unitary integral formation lacks any criticality such that a rejection based on case law is appropriate.
- Note that MPEP 716.01(c)(II) states that "The arguments of counsel cannot take the place of evidence in the record". Note that MPEP 716.02 states "Evidence must show unexpected results... burden on applicant to establish results are unexpected and significant... applicants have burden of explaining proffered data... expected beneficial results are evidence of obviousness".
- "[T]he results of ordinary innovation are not the subject of exclusive rights under the patent laws. Were it otherwise patents might stifle, rather than promote, the progress of useful arts. See U.S. Const., Art. I, section 8, cl.8." In re KSR International Co. v. Teleflex Inc., 82 USPQ2d 1385 (U.S. 2007) (emphasis added). Accordingly, changing a trivial detail of the prior art (such as unitary construction) is at best an "ordinary innovation" if any innovation at all, and therefore does not constitute sufficient reason for patentability.
- Therefore, it would have been obvious to one with ordinary skill in the art at the time the invention was made to modify the housing to be one piece integrally formed unitary and modify the retaining member to be one piece integrally formed unitary for

the benefit of simplifying construction (knowledge generally available as detailed above), and further since the specific number of components lacks any criticality (lacks any unexpected result as detailed above) and in accordance with the rational set forth in the MPEP sections and case law noted above.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection.

### ***Conclusion***

The prior art made of record on the attached PTO-892 form (if any) and not relied upon in the rejections above is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

April 22, 2010

/Victor MacArthur/  
Primary Examiner, Art Unit 3679